APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/896,254	06/29/2001	Joseph L. Hellerstein	YOR920010334US1	9174

7590 03/09/2007	EXAMINER
RYAN, MASON & LEWIS, LLP 90 Forest Avenue Locust Valley, NY 11560	NGUYEN, NGA B

	ART UNIT	PAPER NUMBER
	3692	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/09/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>06 September 2006</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-39</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-39</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date _____.

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

1.   This Office Action is the answer to the communication filed on September 6,

2006, which paper has been placed of record in the file.

2.   Claims 1-39 are pending in this application.

Response to Arguments/Amendment

3.   Applicant's election with traverse of Group I (claims 1-24) in the reply filed on

September 6, 2006 is acknowledged. The traversal is found persuasive. Therefore,

examiner decides to withdraw the Restriction requirement in the last office action and

consider all the claims pending in this application (claims 1-39).

Claim Rejections - 35 USC § 102

4.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by
> another filed in the United States before the invention by the applicant for patent or (2) a patent
> granted on an application for patent by another filed in the United States before the invention by the
> applicant for patent, except that an international application filed under the treaty defined in section
> 351(a) shall have the effects for purposes of this subsection of an application filed in the United States
> only if the international application designated the United States and was published under Article 21(2)
> of such treaty in the English language.

5.   Claims 1-39 are rejected under 35 U.S.C. 102(e) as being anticipated by Chaar et

al (hereinafter Chaar), U.S. Patent No. 6,857,020.

Regarding to claim 1, Chaar discloses apparatus for use in managing a service

level associated with resources in an information technology (IT) system based on

financial terms, the apparatus comprising:

at least one processor operative to: (i) maintain an electronic contract that

contains information pertaining to descriptions of one or more business transactions in

IT terms, financial implications of one or more business transaction service levels, and

reporting to be performed in one or more financial terms; and (ii) measuring the

operation of the IT system in terms of one or more business metrics based on the

electronic contract (column 8, lines 20, the service access controllers, the SLA-specified

service-level monitors); and

memory, operatively coupled to the at least one processor, for storing at least

one of the electronic contract and results of the measurement operation (column 7,

lines 49-50, establishing e-business SLA contract).

Regarding to claim 2, Chaar further discloses wherein the measuring operation

comprises monitoring one or more IT parameters and evaluating results in terms of the

one or more business metrics (column 6, lines 5-15).

Regarding to claim 3, Chaar further discloses wherein the evaluating operation is

performed in real time or at a subsequent time (column 8, lines 15-20).

Regarding to claim 4, Chaar further discloses wherein the measuring operation

comprises accumulating a historical collection of IT data and evaluating results in terms

of the one or more business metrics (column 10, lines 3-14).

Regarding to claim 5, Chaar further discloses wherein the measuring operation comprises collecting measurement data from one or more sources, combining the collected measurement data, and interpreting the collected measurement data in terms of the one or more business metrics (column 9, lines 40-60).

Regarding to claim 6, Chaar further discloses wherein the measurement operation comprises monitoring hardware characteristics of the IT system (column 11, lines 1-10).

Regarding to claim 7, Chaar further discloses wherein the hardware characteristics comprise at least one of temperature and power consumption (column 6, lines 5-15).

Regarding to claims 8-9, Chaar further discloses wherein the measurement operation comprises monitoring software characteristics of the IT system, wherein the software characteristics comprise at least one of bandwidth usage, availability, response time, and latency (column 6, liens 5-15).

Regarding to claim 10, Chaar further discloses wherein the IT system comprises a collection of hardware and software intended to store or deliver data in a digital form (column 11, lines 1-10).

Regarding to claim 11, Chaar further discloses wherein the one or more business metrics comprise a measurement that directly measures the performance of a business (column 10, lines 30-35).

Regarding to claim 12, Chaar further discloses wherein the measurement comprises at least one of an operational cost, customer satisfaction, and relative industry performance (column 10, lines 10-35).

Regarding to claims 13-14, Chaar further discloses wherein the one or more business metrics are converted to one or more financial equivalents, wherein the one or more financial equivalents comprises at least one of a cost of each lost connection, a cost per second of down time, and a relationship between revenue and network latency (column 11, lines 18-23).

Regarding to claim 15, Chaar further discloses wherein results of the one or more business metrics are used to set IT parameters (column 11, lines 23-35).

Regarding to claim 16, Chaar further discloses wherein the one or more business metrics are reported to one or more parties (column 7, lines 10-35).

Regarding to claim 17, Chaar further discloses wherein the one or more business metrics are aggregated so as to obscure details reported to a third party (column 7, lines 10-35).

Regarding to claim 18, Chaar further discloses wherein reporting is performed in financial terms based on the electronic contract (column 11, lines 23-35).

Regarding to claim 19, Chaar further discloses wherein enactment is performed based on financial optimizations using the electronic contract (column 11, lines 23-35).

Regarding to claim 20, Chaar further discloses wherein the one or more business metrics to monitor are inferred from the electronic contract (column 11, lines 23-35).

Regarding to claim 21, Chaar discloses computer-based apparatus for use in managing a service level associated with resources in an information technology (IT) system based on financial terms, the apparatus comprising:

an electronic contract manager module operative to interpret an electronic contract to report on and optimize IT resources based on one or more financial terms (column 5, lines 63-65, SLA manager); and

one or more electronic contract agent modules, operatively coupled to the manager module and residing in one or more elements of the IT system being monitored, operative to enable monitoring, reporting, and enforcing the electronic contract expressed in the one or more financial terms (column 5, lines 65-column 6, line 15, SLA-specified service-level monitors).

Regarding to claim 22, Chaar further discloses an electronic contract authoring system, operatively coupled to the manager module, operative to construct one or more electronic contracts that contain information pertaining to descriptions of one or more business transactions in IT terms, financial implications of one or more business transaction service levels, and reporting to be performed in the one or more financial terms (column 10, lines 48-60).

Regarding to claim 23, Chaar further discloses wherein the manager module is further operative to: (i) identify one or more business transactions; (ii) compute one or more transaction service levels; and (iii) compute one or more business metrics based on the one or more service levels; and (iv) reporting results associated with the one or more business metrics (column 8, lines 30-40).

Regarding to claim 24, Chaar further discloses wherein the manager module is further operative to: (i) identify one or more business transactions; (ii) forecast the one or more transactions over an enactment interval; (iii) predict performance and determine optimizations based on financial criteria; and (iv) initiate actions based on the predicted performance and the determined optimizations (column14, lines 45-65).

Claims 25-39 contain similar limitations found in claims 1-20 above, therefore, are rejected by the same rationale.

Conclusion

6.   Claims **1-39** are rejected.

7.   The prior arts made of record and not relied upon is considered pertinent to applicant's disclosure:

Schwaller et al. (US 6,901,442) discloses methods, system and computer program products for dynamic filtering of network performance test results.

Tobey (US 7,062,455) discloses method and system for tracking computer hardware and software assets by allocating and tagging the asset with an asset tag barcode having a software distribution system (SDS) number and verifying the asset tag barcode upon entry of the asset at a destination site.

8.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner Nga B. Nguyen whose telephone number is (571) 272-6796. The examiner can normally be reached on Monday-Thursday from 9:00AM-6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor Richard E. Chilcot, can be reached on (571) 272-6777.

Any inquiry of a general nature or relating to the status of this application or

proceeding should be directed to the Group receptionist whose telephone number is

(571) 272-3600.

9.   Any response to this action should be mailed to:

> Commissioner of Patents and Trademarks
>
> C/o Technology Center 3600
>
> Washington, DC 20231

Or faxed to:

> (571) 273-8300 (for formal communication intended for entry),

or

> (571) 273-0325 (for informal or draft communication, please label

"PROPOSED" or "DRAFT").

Hand-delivered responses should be brought to Knox building, 501 Dulany

Street, Alexandria, VA, First Floor (Receptionist).

NGA NGUYEN
PRIMARY EXAMINER

March 15, 2006